

REMARKS

Claims 1-109 are currently pending. Pursuant to a restriction requirement issued December 6, 2000, Applicants elected with traverse to proceed with prosecution of the invention defined in Group I claims 1-43, 79, 87-89, 95-98. *Response To Restriction Requirement*, mailed June 6, 2001. If and when these Group I claims are found allowable, Applicants reserve the right to request the amendment of the Group III claims to depend from Group I claims so that they may be rejoined with the Group I claims since the same grounds for patentability of the Group I claims would also impart patentability to the Group III claims. MPEP § 821.04.

Subsequently, pursuant to an election of species requirement, Applicants further elected species (b) graphite fibrils, (c) cylindrical fibrils and (g) structure $[C_nH_L][R'-R]_m$, which read on claims 22, 23, 24, 79, 87-89 and 95-98. *Response to Restriction Requirement*, mailed March 6, 2002. (which included Applicants' explanation again why the restriction requirement was incorrect).

In the Office Action of April 21, 2005, the Examiner required an even further election of a single disclosed species. However, as no guidance as to what further election was required, it was unclear what further species need be elected. In a good faith attempt to comply with the Examiner's request, Applicants further elected the species in the preceding paragraph in which the functional group is carboxyl as recited in claim 89. As a result, in the most recent Office Action of August 11, 2005, the Examiner limited the examination to just claims 87-89.

As an initial matter, Applicants respectfully submit that it is highly improper to continuously and further limit examination of the entire Group I claims 1-43, 79, 87-89, 95-98 after three (3) years of prosecution to just claims 87-89, especially when Applicants have stated that these species are not patentably distinct over each other and the Examiner has not shown

otherwise. Applicants respectfully request that examination on all of Group I claims be conducted.

The Examiner rejected claims 87-89 as anticipated by Bening, et. al. "Surface Chemistry of Fibrillar Carbon" (hereinafter, "Bening"). Applicants respectfully traverse.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. Applicants respectfully submit that Bening fails to teach each and every element in Applicants claims 87-89.

Bening teaches the preparation of oxidized fibrils in which the surface of the fibrils or nanotubes comprise a variety of oxidized groups such as lactones, carboxylic acids, hydroxyl groups, quinones, etc. ("Although the basal planes are quite inert, oxidation results in the introduction of a variety of oxygen-containing functional groups to edges" - p. 420, col. 2, lines 23-24; *also* lines 30-38). These oxidized fibrils are prepared by contacting the fibrils with a strong oxidizing agent such as KClO_3 in H_2SO_4 .

However, Bening does not teach secondary functionalization as claims in Applicants' claims 87-89 in which the fibrils containing oxidized groups are further reacted with another reactant (as recited in claims 87-88) to add certain additional functional groups to the oxidized groups.

As such, Bening does not anticipate Applicants' claims 87-89, and withdrawal of this rejection is respectfully requested.

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Respectfully submitted,

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